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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO.
09 916,122	07.26.2001	Carl Johan Friddle	LEX-0206-USA	8781

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LEXICON GENETICS INCORPORATED  
8800 TECHNOLOGY FOREST PLACE  
THE WOODLANDS, TX 77381-1160

EXAMINER

ULM, JOHN D

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 10/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/916,122

Applicant(s)

Friddle et al.

Examiner

John Ulm

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s).
- 4) ☐ Interview Summary (PTO-413) Paper No(s).
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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- 1) Claims 1 and 2 are pending in the instant application.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- 2) Claims 1 and 2 are rejected under 35 U.S.C. § 101 because they are drawn to an invention with no apparent or disclosed specific and substantial credible utility. The instant application has provided a description of an isolated DNA encoding a protein and the protein encoded thereby. The instant application does not disclose a specific biological role for this protein or its significance to a particular disease, disorder of physiological process which one would wish to manipulate for a desired clinical effect.

It is clear from the instant specification that the receptor protein described therein is what is termed an "orphan receptor" in the art. This is a protein whose cDNA has been isolated because of its similarity to known proteins. There is little doubt that, after complete characterization, this protein may be found to have a specific and substantial credible utility. This further characterization, however, is part of the act of invention and until it has been undertaken Applicant's claimed invention is incomplete. Whereas one could readily employ a putative receptor protein of the instant invention in an assay to identify ligands thereto the information obtained thereby would be of little use until one discovers the identity of those physiological processes moderated by that putative receptor. Because the instant specification has failed to credibly identify a physiological process which has been shown to be influenced by the activation

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or inhibition of a putative receptor protein of the instant invention an artisan would have no way of predicting what effects the administration of that ligand to an organism would have. If one can not predict the effects that the administration of a ligand of the putative receptor of the instant invention is going to have on an organism then it is unclear as to what practical benefit is derived by the public from the identification of that ligand.

The instant situation is directly analogous to that which was addressed in *Brenner v. Manson*, 148 U.S.P.Q. 689 (Sus. Ct, 1966), in which a novel compound which was structurally analogous to other compounds which were known to possess anti-cancer activity was alleged to be potentially useful as an anti-tumor agent in the absence of evidence supporting this utility. The court expressed the opinion that all chemical compounds are "useful" to the chemical arts when this term is given its broadest interpretation. However, the court held that this broad interpretation was not the intended definition of "useful" as it appears in 35 U.S.C. § 101, which requires that an invention must have either an immediately obvious or fully disclosed "real world" utility. The court held that:

"The basic quid pro quo contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived by the public from an invention with substantial utility", "[u]nless and until a process is refined and developed to this point-where specific benefit exists in currently available form-there is insufficient justification for permitting an applicant to engross what may prove to be a broad field", and "a patent is not a hunting license", "[i]t is not a reward for the search, but compensation for its successful conclusion."

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The instant claims are drawn to an isolated nucleic acid encoding a protein of as yet undetermined function or biological significance. There is absolutely no evidence of record or any line of reasoning that would support a conclusion the a protein of the instant invention is associated in any way with a particular mental, biological or medical disorder or disease. Until some actual and specific significance can be attributed to the protein identified in the specification as "NGPCR", or the gene encoding it, the instant invention is incomplete.

The protein encoded by a DNA of the instant invention is a compound known to be structurally analogous to proteins which are known in the art as G protein-coupled receptors. As such, it belongs to a family of proteins of which some members are the targets of over 350 therapeutic agents currently on the market. However, each clinical agent which has been developed by measuring its interaction with a specific G protein-coupled receptor was evaluated against a receptor whose native ligand and physiological function were known, such as the adrenergic receptors, the dopamine receptors and the serotonin receptors. There are also numerous G protein-coupled receptors which do not mediate clinically significant process. More importantly, an artisan knew, before they employed a specific G protein-coupled receptor to identify clinically useful compounds, which physiological process or processes they wished to manipulate and that the protein employed in their assay had an influence of that process. Even if one identifies an agonist or antagonist for a receptor of the instant invention, this information is useless since one has no idea of what clinical effect the administration of that agonist or antagonist to an individual would have. Therefore, in the absence of a knowledge of the natural ligands or

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biological significance of the protein encoded by the claimed nucleic acid, there is no immediately obvious patentable use for it or an isolated nucleic acid encoding it. To employ a protein of the instant invention in the identification of substances which inhibit or induce its activity is clearly to use it as the object of further research which has been determined by the courts to be a utility which, alone, does not support patentability. Since the instant specification does not disclose a credible "real world" use for NGPCR then the claimed invention is incomplete and, therefore, does not meet the requirements of 35 U.S.C. § 101 as being useful.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3) Claims 1 and 2 are rejected under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to use the instant invention for those reasons given above with regard to the rejection of these claims under 35 U.S.C. § 101.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4) Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation "hybridizes under stringent conditions" is conditional and a specific set of definitive conditions are not disclosed in the specification or recited in the claim. Those

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"stringent" conditions described on pages 8 and 12 of the instant specification are expressly identified therein as exemplary ("*e.g.*") and, therefore, not limiting.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

35 U.S.C. § 119(e) states that:

An application for patent filed under section 111(a) or section 363 of this title for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title, by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) of this title, if the application for patent filed under section 111(a) or section 363 of this title is filed not later than 12 months after the date on which the provisional application was filed and if it contains or is amended to contain a specific reference to the provisional application. No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this subsection during the pendency of the application.

5) Claim 1 is rejected under 35 U.S.C. 102(a) as being clearly anticipated by the Bellenson et al. publication (WO01/27158 A2, 19 Apr. 2001), which provided a written description of an isolated nucleic acid encompassed by the instant claim. The nucleic acid presented in SEQ ID NO:45 of the Bellenson et al. publication is 97.2% identical to SEQ ID NO:1 of the instant application and encodes an amino acid sequence (SEQ ID NO:1361) which is 97.1% identical to SEQ ID NO:2 of the instant application. Applicant is advised that the

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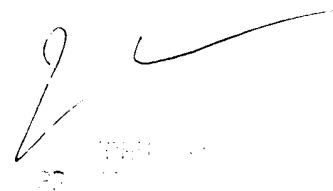
instant application can only receive benefit under 35 U.S.C. § 119(e) from an earlier application which meets the requirements of 35 U.S.C. § 112, first paragraph, with respect to the now claimed invention. Because the instant application does not meet the requirements of 35 U.S.C. § 112, first paragraph, for those reasons given above and it is a divisional of provisional application Serial Number 60/221,012, the prior application also does not meet those requirements and, therefore, is unavailable under 35 U.S.C. § 119(e).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Ulm whose telephone number is (703) 308-4008. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached at (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242 or (703) 872-9306. Official responses under 37 C.F.R. § 1.116 should be directed to (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Handwritten signature and initials, possibly "J. Ulm", with a checkmark-like flourish.